

REMARKS

Claims 9-11 and 21-37 are pending in the present application. In the Office Action mailed November 6, 2006, the Examiner rejected claim 11 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner next rejected claims 9-11 under 35 U.S.C. §103(a) as being unpatentable over Bowsky et al. (USP 5,129,843).

The Examiner rejected claim 11 under 35 U.S.C. §112. Responsive thereto, Applicant has elected to amend claim 11. As amended, Applicant believes that claim 11 conforms to the requirements of §112 and that the rejection should therefore be withdrawn.

The Examiner rejected claim 9 under 35 U.S.C. 103(a) as being unpatentable over Bowsky et al. stating that “Bowsky et al discloses a plastic shield (98) for preventing arc around an electrical stud (7), made of plastic material....” *Office Action*, November 6, 2006, p. 3. The Examiner further stated that “Bowsky et al fail to teach the shield comprising a generally inverted U-shaped configuration” but that “Bowsky et al disclose shape and number of walls can be vary (sic) (col. 4, lines 25).” *Id.* Despite this failure of Bowsky to teach a generally inverted U-shaped shield, the Examiner nonetheless concluded that “it would have been obvious to an ordinary skill in the art at the time applicant’s invention was made to modify the shape of the shield to conform to the arcing directions.” *Id.* Applicant respectfully disagrees with the Examiner’s assertions and believes that the Examiner has mischaracterized the teachings of Bowsky et al. and used improper hindsight in rejecting the claims.

As set forth in MPEP 2143.03, “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” As admitted by the Examiner, Bowsky et al. fails to teach a generally inverted U-shaped shield for preventing arcing from an electrical stud. Rather, Bowsky et al. discloses a terminal assembly 2 that includes conductor pins 7 and is sealed to a wall 4 to extend into a chamber 6. *Bowsky et al.*, Col. 3, lns. 17-21. A plastic block 8 that includes three spaced over-surface open-ended cylindrical wall shields 14 is configured to attach to the

conductor pins 7. *Bowsky et al.*, Col. 4, lns. 12-24. Each cylindrical wall shield 14 extends coextensively with and corresponds to a conductor pin 7 to minimize possible through-space arcing between the pins. *Bowsky et al.*, Col. 4, lns. 12-24. *Bowsky et al.*, however, fails to teach or suggest that wall shields 14 that are placed about conductor pins 7 have a generally inverted U-shaped configuration as called for in claim 9.

Claim 9 specifically calls for a plurality of elements configured to form an inverted U-shaped shield. That is, claim 9 calls for a first planar side having an upper edge; a second planar side having an inner edge, the second planar side being oriented generally perpendicular to the first planar side and extending inwardly from the upper edge of the first planar side; and a third planar side oriented in a plane generally parallel to the plane of the first planar side and extending from the inner edge of the second planar side to form the inverted U-shape. Nowhere in *Bowsky et al.* is it taught or suggested that the wall shields 14 disclosed therein take the form of an inverted U-shape having the elements called for in claim 9. The mere disclosure in *Bowsky et al.* that “the shape and number of wall shields can be varied”, *Bowsky et al.*, Col. 4, ln. 25, is not enough to support the Examiner’s assertion that the cited reference teaches or suggests the inverted U-shaped electrical shield called for in claim 9. The Examiner uses both improper hindsight and the teaching of the present invention to assert that it would have been obvious to one skilled in the art to modify the shields in *Bowsky et al.* to achieve the current invention. Such motivation is improper, as there must be some reason for the [modification] other than the hindsight gained from the invention itself....” *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). As *Bowsky et al.* fails to teach or suggest that which is called for in claim 9, Applicant respectfully believes that claim 9, and the claims dependent therefrom, are patentably distinct over the cited reference.

Claims 12-37 have been canceled. Claims 38-43 have been newly added and are believed to be in condition for allowance.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 9-11 and 38-43.

Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,

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¹The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-2623. Should no proper payment be enclosed herewith, as by credit card authorization being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-2623. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extensions under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-2623. Please consider this a general authorization to charge any fee that is due in this case, if not otherwise timely paid, to Deposit Account No. 50-2623.